

REMARKS

Claims 1-21 are pending in the above application.

The Office Action dated January 10, 2006, has been received and carefully reviewed. In that Office Action, claims 1-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Leong in view of Redd. Because it is believed that the invention required by claims 1-21 is not shown or suggested by the art of record, reconsideration and allowance of claims 1-21 is respectfully requested.

THE EXAMINER HAS NOT ANSWERED ALL MATTERS TRAVERSED IN THE PREVIOUS REPLY

MPEP 707.07(f) provides:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

...

If applicant's arguments are persuasive and upon reconsideration of the rejection, the examiner determines that the previous rejection should be withdrawn, the examiner must provide in the next Office communication the reasons why the previous rejection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks which form the basis for withdrawing the rejection. It is not acceptable for the examiner to merely indicate that all of applicant's remarks form the basis for withdrawing the previous rejection.

MPEP 707.07(f) also includes form paragraph 7.38 which was used in the Office Action to explain that Applicant's arguments are "moot in view of the new grounds of rejection." However, the Office Action does not following the "examiner's note" to form paragraph 7.38 which requires that "The examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." In the previous Reply, Applicant argued that Leong's spooler 410 was not a "customer service system" as required by claim 1. In the present Office Action, however, it appears that spooler 410 is still being treated as a (or part of a) customer service system. However, the present Office Action does not address

Applicant's arguments that spooler 410 is not a customer service system under any reasonable definition of that phrase.

Leong is still being applied in substantially the same manner as in the earlier rejection. Applicant therefore maintains the previously submitted arguments that Leong's spooler 410 is not a customer service system. If these arguments are persuasive, it is submitted that the rejection of claim 1 must be withdrawn. If the arguments are not persuasive, it is respectfully submitted that the examiner should respond to these arguments as required by MPEP 707.07(f). Such an explanation will help the applicant determine whether to file claim amendments or a notice of appeal. It is therefore respectfully requested that, if the rejection of claim 1 is maintained, the examiner respond to Applicant's arguments made in the October 3, 2005, Reply, and explain why this new rejection was necessary, especially given that claim 1 has not been amended.

A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN PRESENTED

Claim 1 is rejected as being unpatentable over Leong in view of Redd. The reason for modifying Leong in view of Redd is stated in the Office Action to be "to upload the content of the print job to the client for printing at one of several output devices." It is respectfully submitted that this appears to be a statement that Leong and Redd can be combined. However, nothing in Leong or Redd provides any reason for making the proposed combination. As provided in MPEP 2143.01, the fact that two references can be combined is not sufficient to establish a *prima facie* case of obviousness. It is still necessary to provide a motivation for combining the references, that is to show why one skilled in the art, unaware of the present disclosure, would have thought to modify Leong in the manner proposed in the Office Action.

In the present case, Leong already prints to multiple output devices. Therefore, the fact that Redd also prints at multiple output devices in no manner suggests any beneficial modification to Leong. It is therefore respectfully submitted that a *prima facie* case of obviousness has not been presented in connection with claim 1, and that claim 1 is allowable over the art of record.

Claims 2-7 depend from claim 1 and are submitted to be allowable for at least the same

reasons as claim 1. In addition, claim 5 further distinguishes over the references of record by requiring a laboratory server be selected based on predetermined information where the predetermined information is "information specifying one of the laboratory servers described in the order information by the customer." The references of record in no manners suggest selecting a laboratory server based on information specifying one of the laboratory servers as required by claim 5. The Office Action does not explain where this limitation is believed to be shown in the references. Therefore, even if a proper motivation for combining Leong and Redd is provided, it is respectfully submitted that claim 5 would distinguish over these references.

Claim 7 is also submitted to distinguish over Leong in view of Redd. The examiner's interpretation of Leong is used below, for sake of argument only, to show that even under this interpretation, claim 7 is not obvious in view of Leong and Redd.

Claim 7 requires that the order assigning system (supervisor 420) transfer information related to the selected laboratory (output devices 500) to the customer service system (spooler 410). Leong does not show supervisor 420 transferring information about output devices 500 to spooler 410. Claim 7 further requires that the customer service system (spooler 410) generate selection information for selecting a desired one of the laboratory servers based on this information. However, the Office Action does not appear to suggest that spooler 410 generates selection information – this is supposedly done by the supervisor system 420. Claim 7 further requires that the customer service system (spooler 410) transfer selection information to the order assigning system (supervisory 420). Even under the interpretation used in the Office Action, Leong does not operate in a manner that would show or suggest the invention of claim 7. Claim 7 is submitted to further distinguish over Leong for these reasons. Therefore, even if a motivation for combining Leong and Redd is provided, claim 7 still distinguishes over these references.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leong in view of Redd. As argued above in connection with claim 1, a motivation for combining Leong and Redd has not been provided, and Leong has not been shown to include a customer service system as required by claim 8. For at least these reasons, claim 8 and its dependent claims 9-14 are submitted to be allowable over the references of record. Claims 12 and 14 are submitted to

further distinguish over the references of record for the reasons provided in connection with claims 5 and 7 above.

Independent claims 15-21 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Leong and Redd. It is respectfully submitted that these claims are allowable over the art of record for at least the reason that a *prima facie* case of obviousness has not been presented in connection with claims 15-21.

As provided in MPEP 2142, if a *prima facie* case of obviousness is not presented, the applicant is under no obligation to provide evidence of non-obviousness. It is therefore submitted that the foregoing response addresses all issues raised in the Office Action dated January 10, 2006, and that claims 1-21 are in condition for allowance. Wherefore reconsideration and allowance of these claims is earnestly solicited.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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